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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,981	12/20/2000	Yoshikazu Kobayashi	362852/99	2679
30743	7590	06/27/2005	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			SCHEIBEL, ROBERT C	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,981

Applicant(s)

KOBAYASHI, YOSHIKAZU

Examiner

Robert C. Scheibel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see page 5, filed 3/28/2005, with respect to the rejection of claim 2 under 35 U.S.C. 112, second paragraph, have been fully considered and are persuasive. The rejection of claim 2 under 35 U.S.C. 112, second paragraph, has been withdrawn.
2. Applicant's arguments, see pages 5-10, filed 3/28/2005 with respect to claims 4, 5, and 7 (and amended claims 1 and 10 which contain similar limitations) have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 1 recites the limitation "the ID" in lines 12 and 15. There is insufficient antecedent basis for this limitation in the claim. This limitation appears to be referring to a specific one of the "IDs" of line 8.
3. Claim 10 recites the limitation "the ID" in lines 14, 17, 20, 20, and 23. There is insufficient antecedent basis for this limitation in the claim. This limitation appears to be referring to a specific one of the "IDs" of line 10.
4. Claim 10 recites the limitation "the ID received via the Internet" in line 23. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **1-3 and 6-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,393,017 to Galvin et al in view of RFC 1531 to Droms.

Regarding claims **1 and 10**, Galvin discloses a telephone controller controlling a plurality of telephones (data devices 102, 104 of Figure 1) connected to the Internet via a LAN (Local Area Network), said telephone controller (the virtual PBX system 100 of Figure 1) allowing an external telephone connected to the Internet to make a direct call to a telephone in the LAN comprising (see figure 9 for example): a memory (object storage data base 110 of Figure 1) in which a table (the combination of the tables in Figures 2-4) indicating a correspondence between IDs (Identifier) of the plurality of telephones (alias 202) and the private IP addresses (address 406) is stored; and a control circuit which controls communication between the plurality of telephones and the Internet using the private IP addresses (processor 108 of Figure 1), wherein the ID includes a domain name of said telephone controller (see Figure 2 and line 40 of column 6) and identification information composed of a user name (clearly part of the email address referred to in line 40 of column 6) and an extension telephone number of the telephone (see lines 41-42 of column 6 which indicates that this id can be composed of any alphanumeric combination including telephone numbers and user names as indicated in the email address) and wherein said memory further stores therein a table indicating a correspondence among the ID, a private IP address, an extension telephone number, and a user name (this correspondence is clearly provided for in the combined table of figures 2-4). Further regarding claim **10**, Galvin discloses the limitation that each of said plurality of telephones includes an input circuit which

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receives the ID and the identification information and sends the ID and the identification information received from said input circuit to said telephone controllers, said control circuit extracts the identification information from the ID received via the Internet, searches said table with the identification information to obtain the private IP address (804 of Figure 8; implicit that the identification information is extracted as it is used to look up the user's network address), and executes communication between a telephone to which the private IP address is allocated and the Internet (806 of Figure 8).

Galvin does not disclose expressly an IP (Internet Protocol) address allocating circuit which allocates a private IP address to each of the plurality of telephones. Galvin also does not disclose expressly the limitation that the correspondence between the IDs and the private IP addresses is stored in a single table.

However, Galvin indicates in lines 50-62 of column 7 that many variations of the organization of information shown in figures 2-4 could be used. At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine tables 2-4 into 1 table. The motivation for doing so would have been to reduce the memory required for this information; there are a number of fields that are duplicated in all three tables.

RFC 1531 discloses a commonly used protocol for automatically configuring hosts with IP addresses among other parameters (described throughout – see the abstract on page 1 for example). This discloses the limitation of the address allocating circuit which allocates a private IP address to each of the plurality of telephones. Galvin and RFC 1531 are analogous art because they are from the same field of endeavor of IP networking. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Galvin to use DHCP

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to automatically configure data devices 102 and 104. The motivation for doing so would have been to allow hosts to discover local configuration parameters without manual configuration as disclosed by RFC 1531 in the first paragraph of page 7. Therefore, it would have been obvious to combine RFC 1531 with Galvin for the benefit of automatically configuring hosts without manual configuration to obtain the invention as specified in claims 1 and 11.

Regarding claim 2, Galvin discloses the limitation that said control circuit extracts the identification information from an ID received via the Internet, searches said table with the identification information to obtain the private IP address (804 of Figure 8; implicit that the identification information is extracted as it is used to look up the user's network address), and executes communication between a telephone to which the private IP address is allocated and the Internet (806 of Figure 8).

Regarding claim 3, Galvin, modified, discloses the limitations of parent claim 1 as discussed above. Galvin does not disclose expressly the limitation that the control circuit notifies the allocated IP address to the telephone. At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the DHCP server in the processor 108 of Figure 1. The motivation for doing so would have been to reduce costs by not requiring additional hardware equipment to add this feature.

Regarding claim 6, Galvin discloses the limitation that the memory further stores therein a table indicating communication history information for each ID in the billing information of lines 49-53 of column 4.

Regarding claim 7, Galvin discloses the limitation that the table is updated in response to a request from the telephone in lines 35-39 of column 7.

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Regarding claim 8, Galvin discloses the limitation of the telephone controller further comprising means for receiving the ID, wherein said control circuit stores the ID received from said means for receiving into said memory in lines 35-39 of column 7.

Regarding claim 9, Galvin discloses the limitation of the transfer circuit which transfers information stored in said table to some other telephone controller in the function of controlling redundancy by the processor(s) 108 described in line 47 of column 4.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Scheibel whose telephone number is 571-272-3169. The examiner can normally be reached on Monday and Thursday from 6:30-5:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RC 6-12-05
Robert C. Scheibel
Examiner
Art Unit 2666

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